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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/293,509      | 04/15/1999  | AKIRA OSAWA          | RM.HPN              | 4957             |

7590 10/23/2002

RAPHAEL A MONSANTO  
ROHM & MONSANTO PLC  
660 WOODWARD AVE SUITE 1525  
DETROIT, MI 48226

EXAMINER

WHITE, CARMEN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3714     |              |

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SO

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/293,509             | OSAWA, AKIRA        |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Carmen D. White        | 3714                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 07 October 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers (abstract)**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15, 16 & 19                    6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Prosecution Application***

The request filed on October 7, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/293, 509 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Abstract***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Double Patenting***

The Double Patenting Rejection set forth in the previous office action (Paper #14) is hereby repeated and incorporated by reference. As previously noted, this rejection can be overcome by a timely filed terminal disclaimer. Until that terminal disclaimer is actually filed, the rejection still stands.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Marnell II* or *Farrell*.

Regarding claims 1-12 and 14, *Marnell* or *Farrell* teaches a gaming machine for use by a player the gaming machine comprising: a variable display for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of predetermined display states; a controller coupled to said variable display for causing said variable display to display the graphical information; and a secondary display having a display area for displaying a plural number of symbol images, the symbol images being associated with one of the plurality of predetermined display states displayed as a result of the principal game, the number of the symbol images displayed in the display area being increased each time that the principal game results in one of the predetermined states, thereby advancing the game (*Farrell*-abstract and Fig. 1; *Marnell*- abstract and Fig. 1). The references are silent on the symbol images being of a single kind. However, the gaming machines are functionally operable to have the symbol images being of a single kind, this is merely a matter of changing the software for the specific kind of secondary game that is desired. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate this feature in *Marnell* or *Farrell* to make to simplify the game and make it easier for the players to learn. (See previous office action, paper #11 for references to

the sections in Marnell or Farrell that teach the feature of the dependent claims, which Applicant has amended for further clarity; however the features are similar and taught by the prior art of record).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Marnell**, II (5,393,057) or **Farrell** (GB 2242300A) in view of **Wilson**, Jr. et al (6,004,207) or **Adams** (5,848,932).

Regarding claim 13, Marnell or Farrell discloses all the limitations of the claim as discussed above. Marnell or Farrell lacks disclosing a multiplied payout. In an analogous gaming machine, Wilson or Adams discloses the multiplication of a payout value (Wilson- abstract; Adams- abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell or Farrell in order to provide multiplied payouts in slot machines to increase players' interests and financial reward in the game.

### **Conclusion**

This is a CPA of applicant's earlier Application No. 09/293,509. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***USPTO Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

  
C. White  
Patent Examiner

  
S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700